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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,757	12/11/2003	James Parks	TN-09667D	1995

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Black & Decker Inc.  
701 E. Joppa Road, TW-199  
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EXAMINER
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PETERSON, KENNETH E

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/734,757	Applicant(s) PARKS ET AL.	
	Examiner Kenneth E Peterson	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 26-28 and 47-52 is/are pending in the application.
- 4a) Of the above claim(s) 47-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

1. Applicant's election with traverse of group I in the reply filed on 23 June 04 is acknowledged. The traversal is on the ground(s) that the claim's dependency change means that there will now be no serious search burden for the Examiner. This is not found persuasive because it is not understood how changing a claim dependency would change the search burden. The subject matter would need to be searched regardless of where it was in any dependency chain.

What Applicant has done is change the relationship between the two groups. Previously, the two groups had been related as subcombinations usable together. Now they are related as combination-subcombination. However, Applicant has provided evidence (original non-dependent claims 47-52) that Applicant himself does not think that the combination (new dependent claims 47-52) rely on the subcombination (unamended claims 26-28) for patentability. See MPEP 806.05(c) example 3.

The requirement is still deemed proper and is therefore made FINAL. Claims 47-52 are hereby withdrawn from consideration.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Shiotani et al.'802, who shows a fence with all of the recited limitations including a handle (404), a rod (405), a first cam (left side of 406) at a first end of the rod, a second

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cam (right side of 406) at the second end of the rod, and first and second movable plates (at 407c, 407c, figure 36B).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiotani et al.'802, who shows a fence with most of the recited limitations.

Shiotani's rod (405) is circular rather than square. Examiner takes Official Notice that it is well known to make such a rod to have square portions, in order to insure co-rotation with joining parts. It would have been obvious to one of ordinary skill in the art to have modified Shiotani by making his rod have a square cross section, as is well known, in order to insure co-rotation with joining parts.

Inasmuch as it can be argued that Shiotani's cam is not "a cam disposed at each end of the rod", it is noted that Shiotani's cam functionally works at two separate locations adjacent each end of the rod. The exact position along the rod, and whether or not Shiotani's cam in one piece or two is a simple choice that can be made by one of ordinary skill in the art. See In re Japikse, 86 USPQ 70 for more on the obviousness of minor positional changes of elements, and see In re Lockhart, 90 USPQ 214 for more on the unity or diversity of parts.

6. Made of record but not relied on are patents to Odum et al. and Biesemeyer showing pertinent fence locks.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 703-308-2186. The examiner can normally be reached on Monday thru Thursday between 7am and 4pm.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9306. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

kp  
August 2, 2004



KENNETH E. PETERSON  
PRIMARY EXAMINER